

## **REMARKS/ARGUMENTS**

In the Office Action mailed April 28, 2010, claims 1-11 and 13-21 were rejected. Additionally, the specification was objected to. In response, Applicants hereby requests reconsideration of the application in view of the amendments and the below-provided remarks. No claims are added or canceled.

For reference, claims 1, 13, 15, and 18 are amended. In particular, claims 1, 15, and 18 are amended to use a spelling for the term “acknowledgment” to be consistent with other instances of the same term in the claims. These amendments are supported by the original language of the claims. Claim 13 is amended to depend from claim 10, rather than from canceled claim 12. This amendment is supported by the original language of the claims. Claim 15 is also amended to recite at least a portion of the assignment system is implemented by instructions stored on a data storage device. This amendment is supported, for example, by the subject matter described in the specification at paragraphs 24, 28-29, and 44, as well as the subject matter illustrated in Fig. 1 of the present application. Claim 18 is also amended to clarify that the recordable medium on which the program product is stored is a recordable data storage medium. This amendment is supported, for example, by the subject matter described in the specification at paragraph 24 of the present application.

### Specification

The Office Action suggests that the application number is missing for the application identified in paragraph 1 of the specification. Applicants submit that the specification is amended to recite the application number of the indicated U.S. patent application.

### Objections to the Claims

The Office Action objects to claims 1 and 15 for using a different spelling of the term “acknowledgment” than is recited in other locations in the claims. Applicants submit that claims 1 and 15, as well as claim 18, are amended to use a spelling for the term “acknowledgment” to be consistent with other instances of the same term in the

claims. Accordingly, Applicants respectfully request that the indicated objections be withdrawn.

Claim Rejections under 35 U.S.C. 112

Claim 13 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, claim 13 was rejected for reciting a claim dependency relative to a canceled claim. Applicants submit that claim 13 is amended to depend from claim 10. Accordingly, Applicants respectfully request that the rejection of claim 13 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claim Rejections under 35 U.S.C. 101

Claims 15-20 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, the Office Action states that claims 15-17 may be interpreted as software per se, and that claims 18-20 do not adequately eliminate transitory, non-statutory embodiments. Applicants submit that claims 15 and 18 are amended to more clearly recite statutory subject matter. In particular, claim 15 is amended to recite at least a portion of the assignment system is implemented by instructions stored on a data storage device. The explicit recitation of a data storage device is statutory subject matter because the data storage device is a physical structural device. Claim 18 is amended to recite a recordable data storage medium, which is also statutory subject matter because the recordable data storage medium is a physical structural device. Accordingly, Applicants respectfully request that the rejections of claims 15-20 under 35 U.S.C. 101 be withdrawn.

Claim Rejections under 35 U.S.C. 103

Claims 1-11 and 13-21 were rejected based on one or more cited references. The cited reference(s) relied on in these rejections include:

Nazari (U.S. Pat. No. 6,842,789, hereinafter Nazari)

Okano et al. (U.S. Pat. Pub. No. 2002/0062485, hereinafter Okano)

Matsuda et al. (U.S. Pat. Pub. No. 2002/0133573, hereinafter Matsuda)  
Meier (U.S. Pat. No. 7,096,273, hereinafter Meier)

In particular, claims 1-3, 5, 6, 9-11, and 14-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nazari, in view of Okano. Claims 4, 7, and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nazari and Okano and further in view of Matsuda. Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Nazari and Okano and further in view of Meier. However, Applicants respectfully submit that these claims are patentable over Nazari, Okano, Matsuda, and Meier for the reasons provided below.

Independent Claim 1

Claim 1 is patentable over the combination of Nazari and Okano because the combination of cited references does not teach all of the limitations of the claim. Claim 1 recites:

A method for assigning a device identifier to a device, the method comprising:

receiving a request at a server from the device for the device identifier, wherein the request is accompanied by correlation data with unique identification information associated with the device;

obtaining the device identifier, the device identifier being unique from device identifiers of other devices identified by the server and distinct from a network address of the device, wherein the device identifier is obtained at the server and associated by the server with the correlation data from the device in response to the request from the device;

marking a status of the device identifier as pending;

sending the device identifier to the device, wherein the device identifier is accompanied by the correlation data associated with the device;

marking the status of the device identifier as in use after receiving an acknowledgment from the device, wherein the acknowledgment is accompanied by the correlation data associated with the device; and

sending a confirmation to the device after the acknowledgment is received, wherein the confirmation is accompanied by the correlation data associated with the device.

(Emphasis added.)

In contrast, the combination of Nazari and Okano does not teach using correlation data with unique identification information associated with the device. For reference, the reasoning in the Office Action recognizes that Nazari does not teach such correlation data. Hence, the reasoning in the present Office Action asserts that Okano purportedly teaches correlation data with unique identification information associated with the device.

However, as a preliminary matter, it should be noted that this assertion in the present Office Action is inconsistent with the explicit statements presented in the Examiner's Answer, which stated that Okano [and Aoyama] "are silent on...the request includes correlation data for the device." Examiner's Answer, 11/20/09, page 11, lines 3-6 (emphasis added).

Moreover, Okano does not teach a request which is accompanied by correlation data with unique identification information associated with the device. Rather, as previously explained in Applicants' submission filed on February 5, 2010, Okano explicitly describes using a common internet protocol (IP) address that is common to all subscriber terminals. Okano, paragraph 84, lines 5-10. The subscriber terminal uses the common IP address "0.0.0.0" which is a fixed value (initial value) common to all subscriber terminals because the subscriber terminal does not have a unique IP address allocated by the dynamic host configuration protocol (DHCP) server. Okano, paragraphs 83-84. Therefore, the assertions in the Office Action are not supported by the actual teachings of Okano.

Furthermore, in light of the failure of Okano to explicitly teach a request which is accompanied by correlation data with unique identification information associated with the device, the Examiner merely concludes without supportive disclosure or evidence that DHCP communications must be accompanied by the media access control (MAC) address of the requesting device, as otherwise communication would not be possible, given that the device is in the process of obtaining a network address. Office Action, 4/28/10, page 6. However, this asserted conclusion is not supported by articulated reasoning with a rational underpinning and, hence, is insufficient to support a *prima facie* case of obviousness. In particular, there is no explanation in the Office Action to show why the described request must include a MAC address of the requesting device in addition to the common IP address that is described in Okano. Moreover, this assertion

in the Office Action is not rational because the asserted conclusion that the MAC address must accompany the request is inconsistent with the explicit disclosure provided in Okano, which describes using the common IP address 0.0.0.0 to identify the requesting device. By using the common IP address 0.0.0.0, there is no need to use additional device addresses.

Furthermore, the Examiner's reasoning in the Office Action calls into question the operability and enablement of the disclosure of Okano. If, as asserted in the Office Action, the MAC address indeed were essential to the functionality of the requesting device, then the failure of Okano to teach using the MAC address would constitute an omission of critical matter from the disclosure and the claims of the cited reference. See MPEP 2164.08(c). This failure to teach subject matter which is characterized by the Examiner as essential or critical to the operation of the device is, under the reasoning provided in the Office Action, evidence of a lack of enablement of Okano. Hence, Okano does not qualify as prior art for the critical aspects that it does not actually teach, including the failure to teach using a MAC address within the indicated request.

For the reasons presented above, the combination of Nazari and Okano does not teach all of the limitations of the claim because the combination of cited references does not teach a request which is accompanied by correlation data with unique identification information associated with the device, as recited in the claim. Moreover, the reasoning in the Office Action is insufficient to establish a *prima facie* case of obviousness because the Office action relies on mere conclusory statements that are not supported by actual teachings or other evidence. Furthermore, the reasoning in the Office Action demonstrates that the disclosure of Okano is not enabled and, hence, cannot be considered prior art for the aspects that Okano does not teach, including the asserted use of MAC addresses. Accordingly, Applicants respectfully assert claim 1 is patentable over the combination of Nazari and Okano because the combination of cited references does not teach all of the limitations of the claim.

#### Independent Claims 10, 15, and 18

Applicants respectfully assert independent claims 10, 15, and 18 are patentable over the combinations of cited references at least for similar reasons to those stated above

in regard to the rejection of independent claim 1. Each of these claims recites subject matter which is similar to the subject matter of claim 1 discussed above. Although the language of these claims differs from the language of claim 1, and the scope of each claim should be interpreted independently of other claims, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejections of these claims.

**Dependent Claims**

Claims 2-9, 11, 13, 14, 16, 17, and 19-21 depend from and incorporate all of the limitations of the corresponding independent claims 1, 10, 15, and 18. Applicants respectfully assert these dependent claims are allowable based on allowable base claims. Additionally, each of these dependent claims may be allowable for further reasons.

## CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the amendments and the remarks made herein. A notice of allowance is earnestly solicited.

This response is accompanied by the appropriate fee to obtain a 1-month extension of the period for responding to the Office Action, thereby moving the deadline for response from July 28, 2010, to August 28, 2010.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **09-0461** pursuant to 37 C.F.R.

1.25. Additionally, please charge any fees to Deposit Account **09-0461** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

/Jeffrey T. Holman/

Date: July 30, 2010

Jeffrey T. Holman  
Reg. No. 51,812

Wilson Ham & Holman  
175 South Main Street  
Suite #850  
Salt Lake City, UT 84111  
Phone: (801) 746-5560  
Fax: (801) 746-7451